

**REMARKS**

Reconsideration and allowance of the subject application are respectfully requested.

Claims 1-4 and 6-34 are all the claims pending in the application. Claim 10 has been amended and is supported at least by Figures 10A-12 of the drawings. Applicant respectfully submits that the pending claims define patentable subject matter.

**I. REJECTION OF CLAIMS OVER PRIOR ART**

**A. Claim Rejections under 35 U.S.C. § 102: Widell**

Claims 1-4, 6-9, 16, 28, and 29 stand rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Widell (2,825,407). The Examiner maintains that Figures 7-9 teach that the guide member 70, 74, and 76 is constituted of projections since they project from the spacers 80.

Applicant respectfully traverses the 35 U.S.C. §§ 102 and 103 rejections as set forth below.

Claim 1 recites that the adjacent punches define a gap therebetween and projections support at least one side face of each of the punches which faces the gap. In Fig. 9 of Widell, the Examiner alleges that the elements 116 (the punch members) are the claimed punches and that the element 76 (the guide plate) is both the claimed guide member and the claimed projections. If assuming, *arguendo*, the adjacent elements 116 define a gap therebetween, a side face of the element 116 which faces the gap is not supported by the element 76 (Fig. 9). Therefore, the element 76 which is considered the claimed projection does not meet the requirements set forth in claim 1.

The claimed apparatus of the present invention is required to perform the punching operation with excellent accuracy. Therefore, several factors that degrade the accuracy have to be removed from the apparatus. For example, the thermal expansion of the punches caused by repeating the punching operation is considered as one of the factors. In Widell, the elements 116 are surrounded by the element 76 without a gap so as to perform the punching operation. In this case, if the elements 116 are thermally expanded, they may not be able to move relative to the element 76, and thus, the elements 116 would not be able to perform the punching operation. However, in claim 1, “the adjacent punches defining a gap therebetween” compensates for thermal expansion in the present invention

Furthermore, although the Examiner maintains that the “projections” are defined as the guide members 70, 74, and 76 that project from the supporting structure 78 and 80 (Office Action, page 3), claim 1 requires that “the guide member [be] formed with projections”. As a distinction over Widell, the guide member itself has projections which project from the guide member. The guide member formed with projections in claim 1 does not have projections projecting from a different structure, other than the guide member, as maintained by the Examiner. Even assuming, *arguendo*, that guide members 70, 74, and 76 project from a separate structure, this is not the same as a guide member formed with projections, as recited in claim 1. One skilled in the art would clearly understand that a projecting guide member (as asserted by the Examiner) is different from a “guide member formed with projections”, as recited

in claim 1. Therefore, the “guide member formed with projections” of claim 1 does not read on the guide members 70, 74, and 76 formed with no projections.

For at least the forgoing reasons, claim 1 is not anticipated by Widell. Therefore, Applicant respectfully requests that the 35 U.S.C. § 102 rejection of claim 1 and its dependent claims 2-4, 6-9, 16, 28, and 29 be withdrawn.

**B. Claim Rejections under 35 U.S.C. § 102: Ekstedt**

Claims 1, 3, 8, 10, 14-16, 19-21 and 28 stand rejected under 35 U.S.C. 102(b) as allegedly being anticipated by Ekstedt (2,309,942). The Examiner maintains that Figures 28-30 teach a guide member 125 that is provided with side portions that support the male die 124 that forms unpenetrated holes in the plate member and the male die 165 that forms penetrated holes in the plate member.

However, nowhere has the Examiner pointed out that in Ekstedt teaches the adjacent punches defining a gap therebetween and the guide member formed with projections that support at least one side face of each of the punches which faces the gap, as recited in claim. Ekstedt fails to teach or suggest the subject matter of claim 1 for similar reasons discussed above for patentability of claim 1 over Widell. Particularly, the male die 124 is surrounded by the alleged guide member 125 without a gap so as to perform the punching operation. Therefore, the same problems arises when thermal expansion occurs. Accordingly, Ekstedt fails to teach or suggest adjacent punches defining a gap therebetween, as recited in claim 1.

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Furthermore, Applicant submits that Ekstedt does not teach or suggest a guide member formed with projections, as recited in claim 1, and the Examiner has not indicated where the same is disclosed in Ekstedt.

For at least the forgoing reasons, claim 1 is not anticipated by Ekstedt. Therefore, the 35 U.S.C. § 102 rejection of claim 1 and its dependent claims 3, 8, 14-16, 19-21 and 28 should be withdrawn.

With respect to claim 10, Ekstedt fails to teach or suggest the subject matter of claim 10.

Claim 10 requires, *inter alia*:

a first male die, adapted to be opposed to a first face of a metallic plate member, the first male die including a plurality of first punches which are provided on the first male die and arranged side by side in a first direction with a fixed pitch, a distal end of each of which has a tapered shape, the first male die for forming recessed portions on the first face of the plate member

Applicant submits that Ekstedt fails to teach or suggest the “first male die” as recited in claim 10. Claim 1 does not read on male die 124 nor male die 165, which have been identified by the Examiner. Further, claim 1 does not read on any dies described in Ekstedt.

For at least the foregoing reasons, claim 1 is not rendered obvious by Ekstedt. Therefore, the 35 U.S.C. § 102 rejection of claim 10 should be withdrawn.

**C. Claim Rejections 35 U.S.C. § 103: Ekstedt**

Claims 11-13 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Ekstedt (2,309,942). As discussed above, Ekstedt is deficient vis-à-vis base claim 10.

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Therefore, dependent claims 11-13 are patentable by virtue of their dependency from claim 10. Thus, claims 11-13 are patentable, and the 35 U.S.C. § 103 rejection of claims 11-13 should be withdrawn.

## **II. INDICATION OF ALLOWABLE SUBJECT MATTER**

Claims 22-27 and 30-34 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form. Applicant submits that the present response places this application in condition for allowance, and therefore, claims 22-27 and 30-34 should be allowed in their present form.

## **III. CONCLUSION**

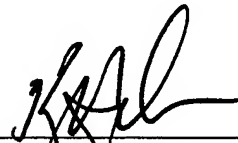
In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

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Respectfully submitted,



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Kelly G. Hyndman  
Registration No. 39,234

SUGHRUE MION, PLLC  
Telephone: (202) 293-7060  
Facsimile: (202) 293-7860

WASHINGTON OFFICE

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